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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,263	11/10/2003	Michael K. Brann	100041-41178	3204

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EXAMINER

GATES, ERIC ANDREW

ART UNIT	PAPER NUMBER
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3722

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/705,263

Applicant(s)

BRANN, MICHAEL K.

Examiner

Eric A. Gates

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25, 28-30, 32, 33, 35, 36, 38-41 and 43-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44 and 45 is/are allowed.
- 6) ☒ Claim(s) 1-25, 28-30, 32, 33, 35, 36, 38-41, 43, 47-49, 51, 52, and 54 is/are rejected.
- 7) ☒ Claim(s) 46, 50 and 53 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's amendment filed on 11 December 2006.
2. The indicated allowability of claim 42 (now canceled, the subject matter of which is included in current claim 25) is withdrawn in view of the newly discovered reference(s) to Ericson. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-23, 32, 33, 40, 41, 46, 47, 51, and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "wherein said binding mechanism is permanently positioned between said first and second edges of said spine" in claims 1, 51, and 54 introduces new matter because the specification does not state how the binding mechanism is attached to the spine, and therefore there was no indication in the original disclosure that the binding mechanism was attached in a permanent manner.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 43 recites the limitation "said support surface" in 4. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 43 depends from canceled claim 27. For the purposes of examination, it has been assumed that claim 43 depends from independent claim 25. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 5-11, 16-18, 21-23, 32, 33, 40, 41 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Ericson (U.S. Patent 2,613,956).

11. Regarding claim 1, Ericson discloses a binder comprising: a spine 3 having a first edge (side closer to label 3 in figure 2) and a second edge (side closer to label 14 in figure 2); a front cover pivotally coupled to said first edge of said spine; a rear cover 2 pivotally coupled to said second edge of said spine, wherein said front cover is directly

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or indirectly attachable to said rear cover to form a self-supporting binder (see figure 2); and a binding mechanism 12 (ring 12 closest to first edge as defined above) fixedly and non-rotatably coupled to said spine, wherein said binding mechanism 12 is coupled to said spine in an off-center manner such that said binding mechanism is located closer to one of said edges than the other one of said edges (see figure 2).

12. Regarding claim 2, Ericson discloses wherein said spine and said covers are generally flat, planar components and are generally rectangular in front view (see figure 2).

13. Regarding claim 3, Ericson discloses wherein said first and second edges are located on opposite sides of said spine (see figure 2).

14. Regarding claim 5, Ericson discloses wherein said binder is movable between a closed position (figure 1), wherein said front and rear covers are generally parallel and facing each other and said binding mechanism is generally located between said front and rear covers, and a display position (figure 2) wherein said front cover is directly or indirectly attached to said rear cover to form a self-supporting binder and said binding mechanism is not generally located between said front and rear covers (as shown in figure 2).

15. Regarding claim 6, Ericson discloses wherein said binder has a generally closed generally triangular shape in end view when said binder is in said display position (as seen in figure 2).

16. Regarding claim 7, Ericson discloses closure means 8/8' located on said front and rear covers for retaining said binder in said closed position (see figures 1 and 2).

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17. Regarding claim 8, Ericson discloses wherein said rear cover 2 includes an extension flap 5/6/7 that is releasably attachable to said front cover when said front cover is directly or indirectly attached to said rear cover (see figure 2).

18. Regarding claim 9, Ericson discloses wherein said extension flap 5/6/7 is pivotally coupled to a main portion of said rear cover 2.

19. Regarding claim 10, Ericson discloses further comprising attachment means 8/8' located on said extension flap and on said front cover, wherein said attachment means can be operated to releasably attach said extension flap to said front cover (see figure 2).

20. Regarding claim 11, Ericson discloses wherein said part 8' of said attachment means located on said front cover is located on an inner surface of said front cover (see figure 1).

21. Regarding claim 16, Ericson discloses wherein said spine 3 includes a longitudinal centerline and said binding mechanism 12 includes a longitudinal centerline (along the length of the ring) which is generally not aligned with said longitudinal centerline of said spine (the longitudinal centerlines are perpendicular, see figure 2).

22. Regarding claim 18, Ericson discloses wherein said binder is configured such that when said front cover is directly or indirectly attached to said rear cover to form a self-supporting binder, said binding mechanism extends generally horizontally (see figure 4, the binding mechanism 12 extends generally horizontally from the spine 3).

23. Regarding claim 21, Ericson discloses further comprising a plurality of sheets 14 bound by said binding mechanism (see figure 3).

24. Regarding claim 22, Ericson discloses wherein said binder is movable to a closed position (see figure 1), wherein said front and rear covers are generally parallel and facing each other and said binding mechanism is generally located between said front and rear covers, and wherein said binder includes closure means 8/8' for retaining said binder in said closed position.

25. Regarding claim 23, Ericson discloses wherein each cover includes an inner edge and an outer edge, each inner edge being coupled to said spine and said outer edge being located generally opposite the associated inner edge (see figure 1), and wherein said closure means 8/8' are located generally adjacent to said outer edges (see figure 1).

26. Regarding claim 32, Ericson discloses wherein at least one of said front or rear cover includes attachment means 8/8' that can be operated to couple front and rear covers to form said self-supporting binder (see figure 2).

27. Regarding claim 33, Ericson discloses wherein said attachment means 8/8' is located on both said front and rear covers (see figures 1 and 2).

28. Regarding claim 40, Ericson discloses wherein said binding mechanism is positioned relative to said spine when said binder is in said closed position, and wherein said binding mechanism is in the same position relative to said spine when said binder is in said display position (see figures 1 and 2).

29. Regarding claim 41, Ericson discloses wherein said spine is generally flat and planar (on the side facing binding mechanism 12), and wherein said front cover is directly pivotally coupled to said first edge, and said rear cover is directly pivotally

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coupled to said second edge, and wherein said generally planar spine is aligned in a plane that is generally parallel to an underlying support surface when the binder is in said self-supporting configuration (the binder may be arranged this way when relatively few pages are bound)

30. Regarding claim 47, Ericson discloses wherein said binding mechanism is directly coupled to said spine and is not directly coupled to said front cover or to said rear cover (see figure 2).

31. Claims 24, 35, 36, 48, 49, and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Ericson (U.S. Patent 2,613,956).

32. Regarding claim 24, Ericson discloses a binder comprising: a spine 3 having a longitudinal centerline; a front cover 1 pivotally coupled to said spine; a rear cover 2 pivotally coupled to said spine, wherein said front cover is directly or indirectly attachable to said rear cover to form a self-supporting binder (see figure 2); and a binding mechanism 12 (ring 12 closer to label 3 in figure 2) fixedly and non-rotatably and directly coupled to said spine and having a longitudinal centerline (along the length of the ring), wherein said binding mechanism is coupled to said spine in an off-center manner (off-center along the length of the spine) such that said longitudinal centerline of said binding mechanism is generally not aligned with said longitudinal centerline of said spine (the longitudinal centerlines are perpendicular, see figure 2).

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33. Regarding claim 35, Ericson discloses wherein at least one of said front or rear cover includes attachment means 8/8' that can be operated to couple front and rear covers to form said self-supporting binder (see figure 2).

34. Regarding claim 36, Ericson discloses wherein said attachment means 8/8' is located on both said front and rear covers (see figure 1).

35. Regarding claim 48, Ericson discloses wherein said binding mechanism 12 is directly coupled to said spine and is not directly coupled to said front cover or to said rear cover (see figure 3).

36. Regarding claim 49, Ericson discloses wherein said binder is movable between a closed position (figure 1), wherein said front and rear covers are generally parallel and facing each other and said binding mechanism is generally located between said front and rear covers, and a display position (figure 2) wherein said front cover is directly or indirectly attached to said rear cover to form a self-supporting binder and said binding mechanism is not generally located between said front and rear covers, and wherein said binder has a generally closed generally triangular shape in end view when said binder is in said display position, and wherein said binding mechanism is positioned relative to said spine when said binder is in said closed position, and wherein said binding mechanism is in the same position relative to said spine when said binder is in said display position.

37. Regarding claim 51, Ericson discloses wherein said spine 3 has a first longitudinal edge and a second longitudinal edge (see figure 2), wherein said front cover is pivotally coupled to said first edge and said rear cover is pivotally coupled to

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said second edge, and wherein said binding mechanism is permanently positioned between said first and second edges of said spine.

38. Claims 25, 28, 29, 38, 39, 43, 52, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Ericson (U.S. Patent 2,613,956).

39. Regarding claim 25, Ericson discloses a method for manipulating a binder comprising: providing a binder having a spine 3 having a first edge (side closer to label 3 in figure 2) and a second edge (side closer to label 14 in figure 2), a front cover 1 pivotally coupled to said first edge of said spine, a rear cover 2 pivotally coupled to said second edge of said spine, and a binding mechanism 12 coupled to said spine, wherein said binding mechanism is coupled to said spine in an off-center manner such that said binding mechanism is located closer to one of said edges (see figure 2); and directly or indirectly attaching said front cover to said rear cover to form a self-supporting binder (see figure 2), wherein said attaching step includes moving said binder from a closed position (see figure 1), wherein said front and rear covers are generally parallel and facing each other and said binding mechanism is generally located between said front and rear covers, to a display position (see figure 2) wherein said front cover is directly or indirectly attached to said rear cover to form a self-supporting binder and said binding mechanism is not generally located between said front and rear covers, and wherein said binder has a generally closed generally triangular shape in end view when in said display position, and wherein said binding mechanism is positioned relative to said

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spine when said binder is in said closed position, and wherein said binding mechanism is in the same position relative to said spine when said binder is in said display position.

40. Regarding claim 28, Ericson discloses wherein said binding mechanism extends generally horizontally when said binder is in said display position (see figure 3, binding mechanism 12 extends generally horizontally from the binder).

41. Regarding claim 29, Ericson discloses wherein said spine 3 includes a longitudinal centerline and said binding mechanism 12 includes a longitudinal centerline (along the length of the ring) which is generally not aligned with said longitudinal centerline of said spine (the longitudinal centerlines are perpendicular, see figure 2).

42. Regarding claim 38, Ericson discloses wherein at least one of said front or rear cover includes attachment means 8/8' that can be operated to couple front and rear covers to form said self-supporting binder.

43. Regarding claim 39, Ericson discloses wherein said attachment means 8/8' is located on both said front and rear covers (see figure 1).

44. Regarding claim 43, Ericson discloses wherein said spine 3 is generally flat and planar (on the side facing binding mechanism 12), and wherein said front cover is directly pivotally coupled to said first edge, and said rear cover is directly pivotally coupled to said second edge, and wherein said generally planar spine is aligned in a plane that is generally parallel to said support surface 5 when the binder is in said self-supporting configuration (the binder may be arranged this way when relatively few pages are bound).

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45. Regarding claim 52 Ericson discloses wherein said binding mechanism 12 is directly coupled to said spine 3 and is not directly coupled to said front cover or to said rear cover (see figure 3).

46. Regarding claim 54, Ericson discloses wherein said binding mechanism 12 is permanently positioned between said first and second edges of said spine.

Claim Rejections - 35 USC § 103

47. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

48. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ericson in view of Wyant (U.S. Patent 5,375,883).

49. Regarding claim 13, Ericson discloses the invention substantially as claimed, except Ericson does not disclose further including a pocket located on an inner surface of said rear cover.

Wyant teaches the use of a binder 10 that includes a pocket 12 on the inner surface 36 of the rear cover 34 for the purpose of retaining a wallet 16 with a calculator 14. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the binder of Ericson with the pocket of Wyant in order to have binder that can be used for holding additional items as desired.

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50. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ericson.

51. Regarding claim 17, Ericson discloses wherein said binding mechanism 12 is located generally adjacent to said one of said edges such that a display sheet 14 bound in said binding mechanism and lies generally flat and parallel with one of said front or rear covers when said binder is in a display position (see figure 3) wherein said front cover is directly or indirectly attached to said rear cover to form a self-supporting binder (see figure 2).

Ericson does not disclose that a display sheet bound in said binding mechanism lies over one of said edges of said spine; however, this requirement does not further limit the claimed and is merely a functional/intended use statement not defining any specific structure of the binding mechanism. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. In this case, a display sheet that is made of larger than normal paper, such as 11 by 17, would fulfill the requirement of the claim without requiring any structural modification to the binder, and therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used such paper in combination with the binder of Ericson for the purpose of displaying a larger sheet of paper.

52. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ericson.

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53. Regarding claim 30, Ericson discloses further comprising the steps of binding a plurality of pages 14 together by said binding mechanism (see figure 2), and displaying said pages such that said pages lie against said front cover 1 in a generally flat manner substantially without any creases in said pages caused by lying over a junction of said spine and one of said covers (see figure 2).

Ericson does not disclose that the pages lie over one of said edges of said spine; however, this requirement does not further limit the claimed and is merely a functional/intended use statement not defining any specific structure of the binding mechanism. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. In this case, a page that is made of larger than normal paper, such as 11 by 17, would fulfill the requirement of the claim without requiring any structural modification to the binder, and therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used such paper in combination with the binder of Ericson for the purpose of displaying a larger sheet of paper.

Allowable Subject Matter

54. Claims 44 and 45 are allowed.

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55. Claims 4, 12, 14, 15, 19, 20, 46, 50, and 53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

56. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

57. For the reasons as set forth above, the rejections are maintained.

Conclusion

58. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG
7 March 2007



MONICA CARTER
SUPERVISORY PATENT EXAMINER